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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,640	04/22/2004	Larry L. Russell	REED1001.12	5335
47953	7590	04/13/2006	EXAMINER	
LAW OFFICE OF KARRY W. WANG 3342 PARK RIDGE DR RICHMOND, CA 94806			PHAM, HUNG Q	
		ART UNIT	PAPER NUMBER	
		2168		
DATE MAILED: 04/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/828,640	RUSSELL, LARRY L.
	Examiner HUNG Q. PHAM	Art Unit 2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 01 February 2006.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-9 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-9 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/01/06 has been entered.

### ***Claim Objections***

Claims 1-4, 6 and 9 are objected to because of the following informalities: *the billboard* in claims 1-4, 6 and 9 (*the outdoor billboard* is suggested), *the user may have seen* in claim 4 (*the user saw* as in claim 1 is suggested). Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1 and 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,823,332**

**B2.**

<u>CURRENT APPLICATION</u>	<u>PATENT 6,823,332</u>
<p><u>Claim 1. A method of providing directed search for a web site address advertised on an outdoor billboard, the method comprising:</u></p> <p style="padding-left: 20px;"><u>creating a database containing one or more web site identifiers input by an advertiser associated with the advertisement of the web site address on the billboard;</u></p> <p style="padding-left: 20px;"><u>permitting a user to search the database by inputting at least one of the web site identifiers; and</u></p> <p style="padding-left: 20px;"><u>providing to the user a search response including one or more web site addresses advertised on the billboard,</u></p> <p style="padding-left: 20px;"><u>wherein the one or more web site identifiers include at least one member of the group consisting of:</u></p> <p style="padding-left: 40px;"><u>a location where the user saw the advertisement of the web site address on the billboard;</u></p> <p style="padding-left: 40px;"><u>a time of day or date or dates when the user saw the advertisement of the web site address on the billboard; and</u></p> <p style="padding-left: 40px;"><u>a product or service associated with the web site address advertised on the billboard.</u></p>	<p><u>Claim 1. A method of providing directed search for a web site address broadcast over a radio, the method comprising:</u></p> <p style="padding-left: 20px;"><u>creating a database containing one or more web site identifiers input by an advertiser associated with the radio broadcast of the web site address;</u></p> <p style="padding-left: 20px;"><u>permitting a user to search the database by inputting at least one of the web site identifiers; and</u></p> <p style="padding-left: 20px;"><u>providing to the user a search response including one or more web site addresses broadcast over a radio,</u></p> <p style="padding-left: 20px;"><u>wherein the one or more web site identifiers include at least one member of the group consisting of:</u></p> <p style="padding-left: 40px;"><u>a location where a listener may receive a radio broadcast of the web site address;</u></p> <p style="padding-left: 40px;"><u>a time of day when the listener may receive the radio broadcast of the web site address;</u></p> <p style="padding-left: 40px;"><u>a date or dates on which the web site address may be broadcast over the radio; and</u></p> <p style="padding-left: 40px;"><u>the name of a disc jockey, celebrity or personality associated with the broadcast of the web site address.</u></p>
<p><u>Claim 6. A method for creating a directed search database of web sites advertised on an outdoor billboard, comprising:</u></p> <p style="padding-left: 20px;"><u>providing each of a plurality of information providers access to a secured portion of the database;</u></p> <p style="padding-left: 20px;"><u>providing each information provider one or more identifier categories;</u></p> <p style="padding-left: 20px;"><u>allowing each information provider to store in the secured portion of the database one or more identifiers associated with a web site advertised on the billboard, each identifier corresponding to an identifier category; and</u></p> <p style="padding-left: 20px;"><u>creating a search query with the one or more identifier categories,</u></p> <p style="padding-left: 20px;"><u>wherein the one or more web site identifiers include at least one member of the group consisting of:</u></p> <p style="padding-left: 40px;"><u>a location where the user saw the advertisement of the web site address on the billboard;</u></p> <p style="padding-left: 40px;"><u>a time of day or date or dates when the user saw, the</u></p>	<p><u>Claim 5. A method for creating a directed search database of web sites broadcast over a radio, comprising:</u></p> <p style="padding-left: 20px;"><u>providing each of a plurality of information providers access to a secured portion of the database;</u></p> <p style="padding-left: 20px;"><u>providing each information provider one or more identifier categories;</u></p> <p style="padding-left: 20px;"><u>allowing each information provider to store in the secured portion of the database one or more identifiers associated with a web site broadcast over the radio, each identifier corresponding to an identifier category; and</u></p> <p style="padding-left: 20px;"><u>creating a search query with the one or more identifier categories,</u></p> <p style="padding-left: 20px;"><u>wherein the one or more identifiers include at least one member of the group consisting of:</u></p> <p style="padding-left: 40px;"><u>a location where a listener may receive a radio broadcast of the web site address;</u></p> <p style="padding-left: 40px;"><u>a time of day when the listener may receive the radio</u></p>

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advertisement of the web site address on the billboard; and a product or service associated with the web site address advertised on the billboard, and  wherein a user searches the database by inputting at least one identifier in the search query, and a search result including a web site associated with the input identifier is provided when the search query is executed.	broadcast of the web site address; a date or dates on which the web site address may be broadcast over the radio; and the name of a disc jockey, celebrity or personality associated with the broadcast of the web site address, and  wherein a user searches the database by inputting at least one identifier in the search query, and a search result including a web site associated with the input identifier is provided when the search query is executed.
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Although the conflicting claims are not identical, they are not patentably distinct from each other because there is no difference between a web site advertised on a billboard and a web site broadcasted over the radio. The methods of the current application and USP 6,823,332 have the same practical application, which is to search the database for a web site associated with the input identifiers.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 6, the step of *creating a search query with the one or more identifier categories* and the clause *wherein a user searches the database by inputting at least one identifier in the search query, and a search result including a web site associated with the input identifier is provided when the search query is executed* make the claim indefinite because there are at least two kind of search criteria in the

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search query, e.g. *one or more identifier categories* and *at least one identifier*, however, the search result includes a web site that matches with the input identifier only, and the *one or more identifier categories* are excluded from the search execution. It is unclear about the function of *the one or more identifier categories* in the query (examiner respectfully suggests applicants to change the clause *search result including a web site* to *search result including at least a web site* because the search result could have one or more web sites that match the search criteria).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Kitano et al.**

**[USP 5,926,116].**

Regarding claim 1, Kitano teaches *a method of providing directed search for a web site address advertised on an outdoor billboard* (FIG. 6 and Col. 5, Lines 19-25), the method comprising: *creating a database containing one or more web site identifiers input by an advertiser associated with the advertisement of the web site address on the billboard* (Col. 3, Line 59-Col. 4, Line 5 and Col. 5, Lines 19-25); *permitting a user to search the database by inputting at least one of the web site identifiers* (Col. 5, Lines 26-36); and

*providing to the user a search response including one or more web site addresses advertised on the billboard*  
(Col. 6, Lines 30-34),

*wherein the one or more web site identifiers include at least one member of the group consisting of:*

*a location where the user saw the advertisement of the web site address on the billboard;*  
*a time of day or date or dates when the user saw the advertisement of the web site address on the*  
*billboard; and*

*a product or service associated with the web site address advertised on the billboard* (The web site identifier is *a location where the user saw the advertisement of the web site address on the billboard* (Col. 5, Lines 26-35)).

Regarding claim 2, Kitano teaches all the claim subject matters as discussed above with respect to claim 1, Kitano further discloses *the search response further includes information related to a web site associated with the web site address advertised on the bill board* (FIG. 7).

Regarding claim 3, Kitano teaches all the claim subject matters as discussed above with respect to claim 1, Kitano further discloses *the one or more web site identifiers further include at least one member of the group consisting of: a subject matter of interest associated with the web site address advertised on the billboard; and the name of a host, celebrity or personality associated with the advertisement of the web site address on the billboard* (Col. 4, Lines 6-14, and Col. 6, Lines 35-39).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitano et al. [USP 5,926,116] in view of Bandera et al. [USP 6,332,127 B1].**

Regarding claim 4, Kitano teaches all of the claimed subject matter as discussed above with respect to claim 1, the location information is obtained by a GPS (Kitano, Col. 5, Lines 31-36), but fails to teach *the location where the user may have seen the advertisement of the web site address on the billboard is defined by one or more members of the group consisting of the name of a highway; the name of a highway exit; the name of a street; the name of a city; the name of a building; and the name of a place of interest.*

Bandera teaches a method for selecting an advertising object to be displayed within a web page requested by a user based on the obtained geographic location via a GPS. Bandera further discloses the GPS obtains *the location where the user may have seen the advertisement of the web site address is defined by the name of a city* (Bandera, Col. 9, Lines 14-20).

It would have been obvious for one of ordinary skill in the art at the time the invention was made to obtain the name of a city using the GPS in order to provide another form of position data to the system for retrieving an advertising object.

**Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitano et al. [USP 5,926,116] in view of Davis et al. [USP 6,269,361 B1].**

Regarding claim 5, Kitano teaches all of the claimed subject matter as discussed above with respect to claim 1, but fails to teach *the database is password protected.*

Davis teaches a method for providing information provider a database account. Davis further discloses the *database account is password protected* (Davis, FIG. 2, item 10).

It would have been obvious for one of ordinary skill in the art at the time the invention was made to use password in order to secure the information of the provider.

Regarding claim 6, Kitano teaches *a method for creating a directed search database of web sites advertised on an outdoor billboard* (FIG. 6 and Col. 5, Lines 19-25), comprising:

*providing each of a plurality of information providers access to a portion of the database* (Kitano, Col. 3, Lines 59-63, a portion of WWW database 3 is provided to information provider to register a file or homepage);

*providing each information provider one or more identifier categories* (Kitano, FIG. 2, Col. 3, Lines 64-67, URL and location);

*allowing each information provider to store in the portion of the database one or more identifiers associated with a web site advertised on the billboard, each identifier corresponding to an identifier category* (Col. 4, Lines 1-14 and Col. 5, Lines 19-25); and

*creating a search query with the one or more identifier categories* (Col. 5, Lines 37-39),

*wherein the one or more web site identifiers include at least one member of the group consisting of*

*a location where the user saw the advertisement of the web site address on the billboard;*

*a time of day or date or dates when the user saw the advertisement of the web site address on the billboard; and*

*a product or service associated with the web site address advertised on the billboard* (The web site identifier is *a location where the user saw the advertisement of the web site address on the billboard* (Col. 5, Lines 26-35)), and

*wherein a user searches the database by inputting at least one identifier in the search query (Col. 5, Lines 22-26), and a search result including a web site associated with the input identifier is provided when the search query is executed (Col. 6, Lines 30-40).*

The portion of the database as taught by Kitano is not *secured* as recited in the claim invention.

Davis teaches a method for providing information provider a database account. Davis further discloses the database account is password protected to secure the database account (Davis, FIG. 2, Item 10).

It would have been obvious for one of ordinary skill in the art at the time the invention was made to use password in order to protect the portion of database that belongs to a particular information provider from an intruder.

Regarding claim 7, Kitano and Davis, in combination, teach all of the claimed subject matter as discussed above with respect to claim 6, Davis further discloses *the secured portion of the database is protected by password* (Davis, FIG. 2, Item 10).

Regarding claim 8, Kitano and Davis, in combination, teach all of the claimed subject matter as discussed above with respect to claim 6, Davis further discloses *each information provider is allowed to store in the secured portion of the database non-identifier information relating the web site* (Davis, FIG. 2, Item 150).

Regarding claim 9, Kitano and Davis, in combination, teach all of the claimed subject matter as discussed above with respect to claim 6, Kitano further discloses *the one or more web site identifiers further include at least one member of the group consisting of: a subject matter of interest associated with the web site address advertised on the billboard; and the name of a host, celebrity or personality associated*

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*with the advertisement of the web site address on the billboard* (Col. 4, Lines 6-14, and Col. 6, Lines 35-39).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TIM T. VO can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HUNG Q PHAM  
Examiner  
Art Unit 2168

April 7, 2006